

REMARKS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the remarks herewith, which place the application into condition for allowance or into better condition for appeal.

Claims 1-14 are pending in this application. No new matter is added herein.

It is submitted that these claims, as originally presented, were in full compliance with the requirements of 35 U.S.C. §112. The remarks presented herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

Claims 1 and 2 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Hoyt; claims 1, 2, 5-7 and 11 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Curro; and claims 8-10 and 12-14 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Curro. The rejections are traversed. None of the cited documents teach, enable, suggest or motivate a skilled artisan to practice the instantly claimed invention.

The instant invention is directed to an insulation material, such as thermally insulating material in sleeping bags and other items. None of the references relied upon by the Office Action, however, provide for an insulation material as instantly claimed.

Hoyt's chamois is not an insulation material. The chamois is merely a drying rag for windows and glass, automobile and marine bodies, and household surfaces. Similarly, Curro's laminate web is not insulation material. The laminate is a clean room wipe, tack cloth, decorative covering, or a food pad. In addition, Curro's laminate web is said to be conductive (paragraph 151, page 15) and is, therefore, by definition not an insulation material.

Applicants also respectfully object to the allegations that the instantly claimed insulation material is “inherently” taught by either Hoyt or Curro. More specifically, the Examiner’s sweeping allegation that “any article, such as those disclosed in the reference, possesses insulating properties to a degree, whether they be heat, sound electrical, etc. insulting properties” is not an adequate basis for rejecting the instant claims.

The Examiner is respectfully reminded that it is not enough to merely allege that because a document purportedly recites disparate materials that the document must “inherently” speak to the instantly claimed invention. Instead, the document must disclose or suggest the properties of the claimed invention for inherency to attach. According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), “such a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection.” The Federal Circuit is clear that “ ‘inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].’ ” *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), *citing to In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, “before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference.” *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original).

Against this background, as the cited documents do not disclose nor suggest the elements and properties of the claimed invention, the Section 102 rejections must fail as a matter of law.

Turning to the Section 103 rejections, the Examiner has not provided a reason why a skilled artisan would be led to practice the instantly claimed invention in light of the cited

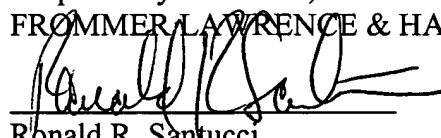
document. Instead, the Examiner appears to suggest that simply because Curro is arguably analogous art, the instant invention would somehow naturally arise therefrom. This is not the standard by which to gauge patentability.

Instead, for the Section 103(a) rejection to be proper, both the suggestion and the expectation of success must be found in the prior art, and not in Applicants' own disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Indeed, hindsight based on Applicants' own success as disclosed and claimed in the present application, is not a justifiable basis on which to contend that the ultimate achievement of the present invention would have been obvious at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1599, 1600 (Fed. Cir. 1988).

Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. *Id.* And as "obvious to try" would be the only standard that would lend the Section 103 rejections any viability, the rejections are fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 103 rejections are believed to be in order and such actions are respectfully requested.

Accordingly, it is respectfully submitted that the claims as presented are in condition for allowance a notice of which is earnestly solicited.

Respectfully submitted,
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